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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,498	01/27/2004	Nicholas J. Elsey	41698.1112	3495
7590 Alex L. Yip Kaye Scholer LLP 425 Park Avenue New York, NY 10022		10/16/2007	EXAMINER ELAHEE, MD S	
			ART UNIT 2614	PAPER NUMBER
			MAIL DATE 10/16/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/766,498	ELSEY ET AL.
	Examiner Md S. Elahee	Art Unit 2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 09/25/2007.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 39-59 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 39-59 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date: _____	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

### *Response to Amendment*

1. This action is responsive to an amendment filed on 09/25/2007. Claims 39-59 are pending.

### *Response to Arguments*

2. Applicant's arguments filed on 09/25/2007 Remarks have been fully considered but they are not persuasive.

Regarding claim 39, the Applicant argues on page 6 that "Rogers does not, as the Office Action alleges, teach or suggest a "third party provider being independent of the directory assistance system". Examiner respectfully disagrees with this argument. In Col. 6, line 61- Col. 7, line 6, Rogers teaches a call for product offered by ABC company [i.e., third party provider] is received by a customer representative in New York [i.e., directory assistance system]. The customer representative transfers the call to assigned sales representative. It clearly means that the third party provider is independent of the directory assistance system. Instead the third party provider is independent of assigned sales representative in Phoenix.

Thus the rejection of the claim in view of Maloney and Rogers remain.

Claim 59 is rejected for the same reasons as discussed above with respect to claim 39.

*Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 43, 44, 47-50, 53 and 59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 43, the phrase "the identified product" in line 2 is indefinite. There are two different "products". It is unclear which "request" is being referred to by the phrase.

Claim 47 and 59 are rejected for the same reasons as discussed above with respect to claim 43.

Since claim 44 is dependent upon claim 43, claims 48-50, 53 are dependent upon claim 47, these claims are also rejected.

*Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 39-44,46-53,55-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Maloney et al.** (US 5,555,299) in view of **Rogers et al.** (US 5,617,471).

As to Claims 39,56, with respect to Figures 4-5, **Maloney** teaches a method for use in a directory assistance system, comprising:

receiving, by a directory assistance system, a call from a caller using a communication device (Col. 9, lines 1-6), the call including a current request for an item purchase from T.I.C Gourmet Foods Catalog (a suggestion of a provider of a product or service) desired by the caller (Col. 9, lines 40-44);

However, **Maloney** does not teach that the item purchase from T.I.C Gourmet Foods Catalog is a third party provider of a product or service and the third party provider being independent of the directory assistance system. **Rogers** teaches specific information on a product (third party provider of a product or service) and the third party provider being independent of the directory assistance system (Col. 6, line 61- Col. 7, line 6). Having the cited analogous art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add a third party provider of a product or service and the third party provider being independent of the directory assistance system to **Maloney's** invention for agent to transparently communicate with customer as taught by **Rogers's** invention in order to provide the customer a specific information of a particular product.

retrieving, from storage, data concerning the manner in which one or more prior requests by the caller to the system were handled (Col. 9, lines 15-24);

utilizing at least the retrieved data concerning the manner in which one or more prior requests were handled to select a third party to identify a product or service provider in response to the current request (Col. 9, lines 24-35, Col. 10, lines 1-8);

searching a database for connection information concerning the selected third party product or service provider (Col. 9, lines 35-45);

facilitating a communication between the caller and the selected third party product or service provider based on the connection information (Col. 9, lines 35-45);

storing, in the storage, data concerning the manner in which the current request is handled (Col. 9, lines 45-54);

after the caller communicates with the selected third party product or service provider, allowing the caller to transfer automatically, in response to a predetermined signal received from the caller's communications device (Col. 9, line 45-54, Col. 10, lines 51-66).

**Maloney** does not teach that "allowing the caller to return to the directory assistance system without terminating the call".

However, it is obvious that **Maloney** suggests the limitation. This is because **Maloney** teaches transferring a caller from one call center to another call center and determines after each transfer, whether further transfer needs to take place by asking the caller "Is there anything else I can help you with today?" (Figure 5, label 142). This teaching suggests that a caller, after being transferred from call center 50 to call center 71 can request transfer back to call center 50 to purchase further items. Therefore, at the time the invention was made, it would have been

Art Unit: 2614

obvious to one of ordinary skill in the art to add return callers to call center 50 after being serviced at call center 71 so as to allow a caller to purchase the navy coat or purchase other apparel.

As to Claim 40, **Maloney** teaches the method of claim 39, wherein the one or more prior requests were received in the same call as the current request (Col. 9, lines 30-45 and Col. 10, lines 1-15).

As to Claim 41, **Maloney** teaches the method of claim 39, wherein the connection information including a telephone number (Col. 9, lines 15-18).

As to Claim 42, **Maloney** teaches the method of claim 41, wherein the communication includes telephone connection (Figure 1).

As to claim 43, **Maloney** teaches the method of claim 39, wherein the caller is returned to the directory assistance system automatically after a disconnection by the identified product or service provider of the communication between the caller and the identified product or service provider (Col. 9, lines 45-52).

As to Claim 44, **Maloney** teaches the method of claim 43, wherein the caller is returned to the directory assistance system after seconds (a predetermined period) from the disconnection (Col. 9, lines 65-67).

Art Unit: 2614

Claims 46,58 are rejected for the same reasons as discussed above with respect to claim 39.

Furthermore, **Maloney** teaches a method for use in a directory assistance system, comprising:

assigning software (an agent in the directory assistance system), the software (agent) communicating with the third party product or service provider on behalf of the caller to satisfy the current request (Col. 9, lines 45-54); and

storing, in the directory assistance system, data concerning the current request in association with the caller (Col. 9, lines 23-24).

As to Claim 47, **Maloney** teaches the method of claim 46, further comprising receiving information concerning the caller, and generating a ticket containing details of the desired product or service, wherein select fields of the ticket are populated with the received information (Col. 9, lines 15-25).

As to Claim 48, **Maloney** teaches the method of claim 47, wherein the received information comprises the caller's telephone number (Col. 9, lines 15-17).

As to Claim 49, **Maloney** teaches the method of claim 47, wherein the received information comprises the caller's home address (Col. 9, lines 25-26).

As to Claim 50, **Maloney** teaches the method of claim 47, wherein the received information comprises the caller's present location (Col. 15-19).

Art Unit: 2614

As to Claim 51, **Maloney** teaches the method of claim 46, wherein the retrieved data comprises one or more caller preferences (Col. 9, lines 1-5).

As to Claim 52, **Maloney** teaches the method of claim 51, wherein the one or more caller preferences include preferences for selected company divisions (geographic regions) (Col. 9, lines 1-5).

As to Claim 53, **Maloney** teaches the method of claim 47, further comprising entering the food division (name of the product or service provider) at which a reservation is desired on the ticket, accessing a database to retrieve other information regarding the product or service provider, and automatically populating selected fields of the ticket with said other information (Col. 9, lines 45-51,55,65).

Claims 55,57,59 are rejected for the same reasons as discussed above with respect to claim 39.

Furthermore, **Maloney** teaches a method for use in a directory assistance system, comprising:

identifying a foods product division (geographical region) based on the record (Col. 9, lines 42-45);

transferring the record to call center 71 (a call center) associated with the foods product division (geographic region) (Col. 9, lines 55-67);

identifying a third party provider of a product or service that is not associated with call center 50 (the directory assistance system) and is located in the geographical region, based at least on the data concerning prior requests contained in the record (Col. 9, lines 55-67).

Art Unit: 2614

8. Claims 45,54 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Maloney** et al. in view of **Rogers et al.** further in view of **Marwell et al.** (US 6,404,884).

As to Claims 45,54, **Maloney** teaches the method of claim 39, wherein the identified product or

service provider includes purchasing from catalogs;

**Maloney** in view of **Rogers** does not teach the following limitation:

“a restaurant”

However, it is obvious that **Maloney** suggests the limitation. This is because **Maloney** teaches order and service placements using CSRs (Col. 1, lines 37-40). **Marwell** teaches CSR placement of restaurant services (Col. 18, line 66 through Col. 19, line 3). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to restaurant reservations to **Maloney**’s invention in view of **Rogers** for additional service offerings as taught by **Marwell**’ invention in order to maximize services and responsiveness to customers.

### *Conclusion*

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Md S. Elahee whose telephone number is (571) 272-7536. The examiner can normally be reached on Mon to Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*Md. Shafiqul Alam Elahee*  
MD SHAFTUL ALAM ELAHEE  
Examiner  
Art Unit 2614  
October 14, 2007